

The Examiner has maintained the rejection of claims 1-7, 9, 11, 17-18 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,602,116 issued to Knutson and Kobayashi et al (Anal Biochem 244(2): 374-83, Jan 1997) in view of Bauss (Calcif Tissue Int 59(3); 168-73, Sept 1996, PTO 892). This 103 rejection is the only issue remaining in the prosecution of this patent application.

In the Patent Office action mailed on December 4, 2001, the Examiner indicated the following:

Applicants' arguments filed 9/13/01 have been fully considered but are not found persuasive. Applicants' position is that the Knutson patent is not available under section 103(a) and section 103(c) since the invention in the present application and the Knutson patent were commonly owned by the assignee, Bone Care International, Inc., at the time the instant invention was made. However, since the international filing date of the application is before November 29, 1999, to be entitled to the provisions of 103(c), applicant should file a new application such as a CPA.

During a telephone conversation between Supervisory Patent Examiner (SPE) Christina Chan and the undersigned on January 9, 2002, SPE Chan essentially mimicked the Examiner's above comments and further indicated that the filing of a CPA accompanied by appropriate evidence of common ownership should place the application in condition for allowance.

Applicant also wishes to note section 706.02(l)(1) of the Manual of Patent Examining Procedure (MPEP):

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant filed on or after November 29, 1999, including ... continued prosecution application[s] filed under 37 C.F.R. 1.53(d) .... The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999 .... [However, t]he mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application.

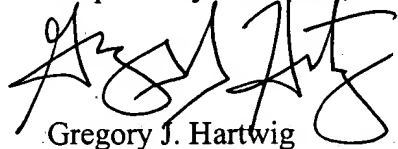
In view of the Examiner's comments and the cited portion of the MPEP, Applicant has filed this continued prosecution application (CPA) under 37 C.F.R.

1.53(d). Accompanying the CPA is the required evidence of common ownership which was previously filed with Applicant's September 10, 2001 response.

**CONCLUSION**

Consequently, consideration of the CPA and allowance of the application are respectfully requested. Should, for some reason, the Examiner deem the application not allowable, Applicant formally requests a telephonic interview with the Examiner. The undersigned also remains available for telephone consultation at any time.

Respectfully submitted,



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